



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/664,703 | 09/18/2003 | Eric Holmes | 71034 | 5196 |

23872 7590 11/18/2005
MCGLEW & TUTTLE, PC
P.O. BOX 9227
SCARBOROUGH STATION
SCARBOROUGH, NY 10510-9227

EXAMINER

FERGUSON, MICHAEL P

ART UNIT PAPER NUMBER

3679

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,703

Applicant(s)

HOLMES, ERIC

Examiner

Michael P. Ferguson

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 30-49 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,9,44 and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,8,30-43 and 45-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 5,6,9,44 and 49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 6, 2005.

Claim Objections

2. Claims 30,36,39 and 41-43 are objected to because of the following informalities:

Claim 30 (line 9) recites "molded material molded". It should recite --a molded material part molded--.

Claim 30 (line 11) recites "said molded material". It should recite --said molded material part--.

Claim 30 (line 12) recites "groove surface, said groove surface". It should recite --groove, said groove--.

Claim 36 (line 4) recites "said groove surface". It should recite --said groove--.

Claim 39 (line 5) recites "area region integral". It should recite --area regions integral--.

Claim 41 (line 10) recites "bearing shell surface". It should recite --bearing shell portion--.

Claim 41 (line 11) recites "groove surface, said groove surface". It should recite --groove, said groove--.

Claim 42 (line 2) recites "said housing". It should recite --said housing part--.

Art Unit: 3679

Claim 42 (line 3) recites "in said for receiving bellows". It should recite --in said bellows--.

Claim 43 (line 4) recites "area region integral". It should recite --area regions integral--.

For the purpose of examining the application, it is assumed that appropriate correction has been made.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4,7,8,30-43 and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Schutt et al. (US 5,611,635).

As to claim 1, Schutt et al. disclose a ball-and-socket joint capable of use with motor vehicles, the ball-and-socket joint comprising:

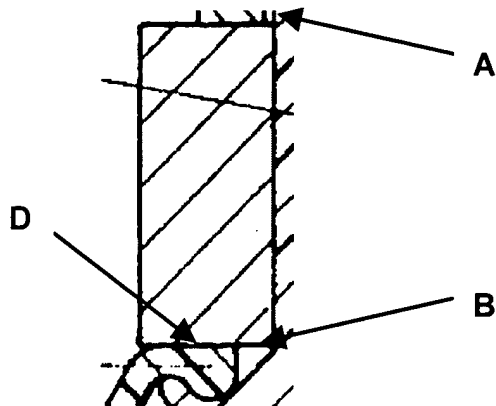
a joint ball **2a** and a pivot pin **2d**;

a housing part **1** formed of a shaped metal tube and formed with a top end edge **A** (Figure 1 reprinted below with annotations) with an opening and an opposite end with a pivot pin opening having a pivot pin opening edge **B**, the housing part having an outer peripheral surface (defined by top, bottom and side cylindrical surfaces of housing part **1**) at an outside of the housing part extending from the top end edge to the pivot pin

Art Unit: 3679

opening edge and having an inner peripheral surface **1a** at an inside of the housing part extending from the top end edge to the pivot pin opening edge; and

molded material **3** disposed on the housing part outer surface and inner surface forming functional surfaces on each of an inside **1a** and an outside of the housing part (Figures 1 and 2).



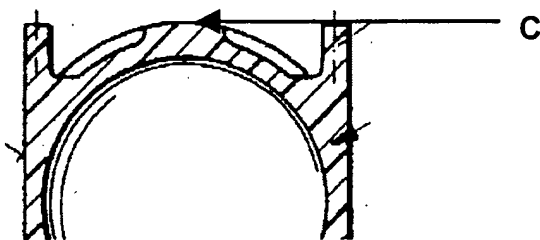
The applicant is reminded that patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production. " In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985).

As to claim 2, Schutt et al. disclose a ball-and-socket joint wherein the functional surfaces include a bearing shell portion **3b** forming a part of a bearing shell surface on the inside **1a** of the housing part **1** and a bellows seat surface contour **3e,D** on an outside of the housing part (Figure 1).

Art Unit: 3679

As to claim 3, Schutt et al. disclose a ball-and-socket joint wherein the bearing shell portion **3b** forms an entire bearing shell surface in contact with substantially all of a bearing surface of the joint ball **2a** (Figure 1).

As to claim 4, Schutt et al. disclose a ball-and-socket joint wherein the bearing shell surface **3b** includes extension segments **3d,C** integral with the bearing shell surface and extending from a region of the bearing shell surface disposed on the housing part **1**, the extension segments being molded to a shape to form a joint ball end region bearing surface (Figure 1).



As to claim 7, Schutt et al. disclose a ball-and-socket joint comprising an end cap **4** wherein the housing part **1** is formed as a shaped metal tube with the top end having an opening and the end cap closes the opening (Figure 1).

As to claim 8, Schutt et al. disclose a ball-and-socket joint wherein the functional surfaces on each of the inside **1a** and the outside of the housing part **1** are formed of one molded part wrapping around an edge of the housing part (Figure 1).

As to claim 30, Schutt et al. disclose a ball-and-socket joint for motor vehicles, the ball-and-socket joint comprising:

a joint ball **2a** and a pivot pin **2d**;

a housing part **1** formed of a shaped metal tube and formed with a top end edge **A** with an opening and an opposite end with a pivot pin opening having a pivot pin

Art Unit: 3679

opening edge **B**, the housing part having an outer peripheral surface (defined by top, bottom and side cylindrical surfaces of housing part **1**) at an outer end of the housing part extending from the top end edge to the pivot pin opening edge and having an inner peripheral surface **1a** at an inside of the housing part extending from the top end edge to the pivot pin opening edge; and

a molded material part **3** disposed on the housing part outer peripheral surface and inner peripheral surface forming functional surfaces on both of the inside **1a** and the outside of the housing part and the molded material part disposed on the housing part outer surface to form a groove **3e,D**, the groove being in a molded material part region with the pivot pin opening edge arranged therein (Figures 1 and 2).

The applicant is reminded that patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production. " In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985).

As to claim 31, Schutt et al. disclose a ball-and-socket joint wherein the pivot pin opening edge **B** is covered by the molded material part **3** with the molded material part extending outwardly therefrom and outwardly from the adjacent outer peripheral surface and inner peripheral surface **1a** of the housing part **1** (Figure 1).

As to claim 32, Schutt et al. disclose a ball-and-socket joint wherein the groove **3e,D** is partially defined by a portion **D** of the housing part **1** adjacent to the pivot pin

Art Unit: 3679

opening edge **B**, with the groove having a curve along an axial extent (of molded material part **3**) thereof (Figure 1).

As to claim 33, Schutt et al. disclose a ball-and-socket joint wherein the groove **3e,D** is annular extending around the housing part **1** (Figure 1).

As to claim 34, Schutt et al. disclose a ball-and-socket joint wherein the molded material part **3** is an integral single piece (Figure 2).

As to claim 35, Schutt et al. disclose a ball-and-socket joint wherein the groove **3e,D** is partially defined by a curve (annular surface of) in a portion **D** of the housing part **1** adjacent to the pivot pin opening edge **B** with the groove having a curve along an axial extent (of molded material part **3**) thereof (Figure 1).

As to claim 36, Schutt et al. disclose a ball-and-socket joint wherein the housing part **1** is covered by the molded material part **3** disposed on the inner surface to form a part of a joint ball pivot bearing surface **3b** on the inside of the housing part and on the housing part outer surface to form the groove **3e,D** (Figure 1).

The applicant is reminded that patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production. " In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985).

As to claim 37, Schutt et al. disclose a ball-and-socket joint wherein the molded material of the molded material part **3** is arranged on the inner surface **1a** to form a part

Art Unit: 3679

of a joint ball pivot bearing surface **3b** on the inside of the housing part **1** and on the housing part outer surface to form a groove surface **3e,D** (Figure 1).

As to claim 38, Schutt et al. disclose a ball-and-socket joint wherein the pivot pin opening edge **B** is covered by the molded material part **3** with the molded material part extending outwardly therefrom and outwardly from the adjacent outer peripheral surface and inner peripheral surface **1a** of the housing part **1** (Figure 1).

As to claim 39, Schutt et al. disclose a ball-and-socket joint wherein the molded material of the molded material part **3** is arranged on the inner surface **1a** to form a part of a joint ball bearing shell portion **3b** on the inside of the housing part **1** and on the housing part outer surface to form a groove surface **3e,D** wherein the bearing shell portion includes extension segments **3d,C** with adjacent folded area regions integral with the bearing shell portion and extending from a region of the bearing shell portion molded on the housing part, the extension segments being molded to a shape to form a joint ball end region bearing surface (Figures 1 and 2).

As to claim 40, Schutt et al. disclose a ball-and-socket joint wherein the molded material part **3** is an integral single piece (Figure 1).

As to claim 41, Schutt et al. disclose a ball-and-socket joint for motor vehicles, the ball-and-socket joint comprising:

a joint ball **2a** and a pivot pin **2d**;

a housing part **1** formed of a shaped metal tube and formed with a top end edge **A** with a top opening and an opposite end with a pivot pin opening having a pivot pin opening edge **B**, the housing part having an outer surface (defined by top, bottom and

Art Unit: 3679

side cylindrical surfaces of housing part **1**) at an outside of the housing part extending from the top end edge to the pivot pin opening edge and having an inner surface **1a** at an inside of the housing part extending from the top end edge to the pivot pin opening edge; and

molded material part **3** disposed on the housing part inner surface to form a part of a joint ball pivot bearing shell portion on the inside of the housing part and the molded material disposed on the housing part outer surface to form a groove **3e,D**, the groove being defined by a curved portion (annular surface **D** of) of the housing part adjacent to the pivot pin opening edge, cooperating with the molded material on the housing part outer surface (Figures 1 and 2).

The applicant is reminded that patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production. " In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985).

As to claim 42, Schutt et al. disclose a ball-and-socket joint comprising a bellows seal **5**, wherein the groove **3e,D** is a bellows seat surface contour on an outside of the housing part **1**, the bellows seal having a portion seated in the bellows seat surface contour (Figure 1).

As to claim 43, Schutt et al. discloses a ball-and-socket joint wherein the molded material of the molded material part **3** is arranged on the inner surface **1a** to form the joint ball bearing shell portion **3b** on the inside of the housing part **1** wherein the bearing

Art Unit: 3679

shell portion includes extension segments **3d,C** with adjacent fold area regions integral with the bearing shell portion and extending from a region of the bearing shell portion molded on the housing part, the extension segments being molded to a shape to form a joint ball end region bearing surface wherein the bearing shell portion and the joint ball end region bearing surface forms the entire bearing shell (Figures 1 and 2).

As to claim 45, Schutt et al. disclose a ball-and-socket joint comprising an end cap **4** connected to the housing part **1** at the top end edge **A**, the end cap closing the top opening (Figure 1).

As to claim 46, Schutt et al. disclose a ball-and-socket joint wherein the groove **3e,D** is annular extending around the housing part **1** (Figure 1).

As to claim 47, Schutt et al. disclose a ball-and-socket joint wherein the molded material part **3** is an integral single piece.

As to claim 48, Schutt et al. disclose a ball-and-socket joint wherein the molded material part **3** wraps around the pivot pin opening edge **B** of the housing part **1** (Figure 1).

Response to Arguments

5. Applicant's arguments filed August 22, 2005 have been fully considered but they are not persuasive.

As to claims 1,30 and 41, Attorney argues that:

Schutt et al. do not disclose a ball-and-socket joint comprising a housing part *having an outer peripheral surface at an outside of the housing part extending from the top end edge to the pivot pin opening edge and having an inner*

peripheral surface at an inside of the housing part extending from the top end edge to the pivot pin opening edge.

Examiner disagrees. As to claims 1,30 and 41, Schutt et al. disclose a ball-and-socket joint comprising a housing part **1** having an outer peripheral surface (defined by top, bottom and side cylindrical surfaces of housing part **1**) at an outside of the housing part extending from the top end edge **A** to the pivot pin opening edge **B** and having an inner peripheral surface **1a** at an inside of the housing part extending from the top end edge to the pivot pin opening edge (Figures 1 and 2).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Ferguson whose telephone number is (571)272-7081. The examiner can normally be reached on M-F (8:00-5:00).

Art Unit: 3679

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571)272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MPF
11/09/05



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

REPLACEMENT SHEET

APPROVED
MPS
11/9/05

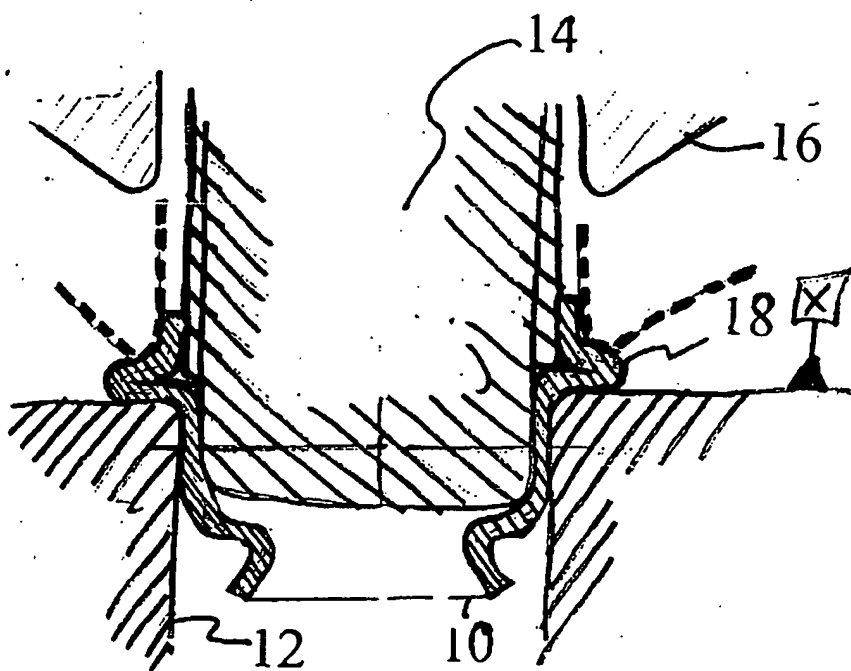


FIG 5